

II. REMARKS

A. Introduction

In this Office Action claims 1-32 are noted as pending and are rejected.

In summary of this Response a Terminal Disclaimer is submitted, the written description, drawings and claims 1-5, 8, 10-12, 14-17, 19-22, 24-26 and 30-32 are amended, new claims 33-42 are added to afford a differing scope of protection for the invention to which the applicant is entitled, and remarks are provided.

As noted below, new claims 33-38 relate to allowable claims 1/3, 1/4, 5/6, 7, 8/10 and 8/11.

New claims 39 and 41 recite the opening 3a formed in the body of the toy. See, e.g., page 8, lines 5-6 of the application as filed.

New claims 40 and 42 recite the removability of the body from the toy. See, e.g., page 8, lines 1-5 and paragraph 38.

B. Obviousness-Type Double Patenting Rejection

In the Office Action, an obviousness-type double patenting rejection is made for claims 1-32 over the claims 1-31 of the parent, U.S. Patent No. 6,783,423.

In response thereto, attached is a Terminal Disclaimer of the Assignee signed by the undersigned.

Also attached is the appropriate \$130 disclaimer fee set by 37 C.F.R. §1.20(d).

In light of the filing of this Terminal Disclaimer, it is respectfully submitted that this double patenting rejection has been overcome.

C. Objection to Drawings

The drawings are objected to for allegedly not showing the battery containing part. Reference numeral "4a" has been added to FIG. 2 to indicate the portion of the chassis that receives the battery, as described in the Specification. The clip 5 holds the battery in place in this part 4a. See, e.g., page 8, line 26.

D. Objection to the Specification

The Examiner suggests that the terms "radiation plate" and "radiation effect" are literal translations and requests clarification. Relatedly, various of the claims are rejected on the

Amendments to the Drawings:

The attached sheet of drawings includes changes to Fig. 2. This sheet, which includes Figs. 1 and 2, replaces the original sheet including Figs. 1 and 2.

In Figure 2, the reference numeral "4a" is added to identify the battery containing part described in the Specification.

Attachment: Replacement Sheet and Annotated Sheet Showing Change

ground that the meaning of "a shape [or form] with a high radiation effect" is not clear.

To improve clarity, the specification at numbered paragraph 12 has been amended to indicate that the motor holding plate 8, in one embodiment, can also serve as a heat radiator or radiation plate when it is made of, e.g., copper, as also described more fully at, e.g., numbered paragraph 35. This plate promotes dissipation of the heat that is inherently generated by the motor adjacent thereto.

The metal holding plate can also serve as an electrical conductor to conduct electrical power from the battery to the side of the motor. See, e.g., numbered paragraphs 16 and 17 and claims 1 and 11.

Alternatively, the plate 8 can be a resin, but configured as shown, e.g., in Figs. 2-4 to include openings which allow heat to move away from the motor and through the plate 8.

Further, in any of these embodiments, a rear portion of the toy body can be provided with an opening 3a (Fig. 1) for further promoting the dissipation of heat from the motor, through the plate 8 to the ambient air.

The claims have been amended, where appropriate, to clarify these issues.

The Examiner also questions whether the motor containing part is conductive per se, or whether only some of the pieces thereof are conductive. As noted in, e.g., numbered paragraph 33, portions of the motor containing part are electrically conductive, e.g., conductive pieces 6a and 6b. Where appropriate, the claims have been amended to clarify this structure.

E. Noted Allowability of Claims

Claims 3, 6, 7 and 10 are noted as allowable and claims 4 and 11 are rejected only based on double patenting and 35 U.S.C. § 112, which rejections are believed overcome herein.

Claims 3, 4, 6, 7, 10 and 11 have been put into independent form, where necessary, as respective new claims 33-38, and are believed to be in allowable condition.

F. Rejection of Claims 1 and 8
Under 35 U.S.C. §102

These claims have been rejected as being anticipated by Dicke, U.S. Patent No. 4,028,571. The Office Action indicates that this reference shows a motor housing having a hinged cover.

In response thereto, it is respectfully submitted that the present invention, as recited by amended claims 1 and 8, was neither anticipated nor made obvious by the cited prior art for the following reasons.

As a reminder, one of the purposes of the present invention is to allow quick and easy replacement of motors for running toys. See, e.g., paragraphs 5, 6, 14 and 23 of the application as filed. In this regard, not only does the present invention provide a faster and easier to use motor holding plate for motor replacement than the conventional plates, but the motor holding plate facilitates easier electrical connection for the motor, eliminating the conventional need to rely upon an electrical connection fixed to the motor ("With a motor to which a conductive wire is adhered, the conductive wire is required to be attached and detached with solder, so that is much bother." Page 2, lines 4-6 of the present application).

With the present invention as recited by amended claims 1 and 8, the motor holding plate is movable between a first position, wherein the motor containing part is open, and a second position wherein the motor containing part is closed. When the motor holding plate is in the second "closed" position, the motor is contained in the motor containing part and is thereby simply electrically connected to a power source. In contrast, when the motor holding plate is in the first position, and the motor is not in the motor containing part, the motor is not electrically connected to the power source.

Dicke relates to a control mechanism for an antenna rotator (Col. 1, line 7). The mechanism includes a housing 70 for a motor 16. The motor 16 appears permanently connected to power source wires (Fig. 4) that extend out of the housing 70. The motor 16 is mounted in the housing 70 with the wires attached, and the cover 77 is closed and secured to the base via the hooks 86, 87 and 88. Note also that Dicke requires lining-up a pin and hole (83, 84) combination and receiving ribs 81 in the walls 72, to close the cover 77 relative to the walls 72. Col. 4, lines 32-36.

Dicke includes no structure by which securing the cover of the housing affects electrical connection of the motor, since the motor is always connected to the wires, as is conventional. When the cover 77 is secured, the motor is contained in the housing, and the motor is connected to a power source. When the cover is open, and when the motor is outside of the housing, the motor is still connected to the power source.

There is no motivation in Dicke to make the motor easily replaceable, as it appears a goal of Dicke is to merely provide a "cover member which can be hinged and secured to the base of housing without requiring external fastening means" (Col. 2, lines 51-53), not to easily replace the motor. In fact, in order to replace the motor of Dicke, the various gears 25, 26, etc. have to be removed, which would frustrate easy motor replacement.

It is also believed that Dicke includes no suggestion as to how the connection/disconnection to the power source can be made, depending upon the position of the cover of the housing/position of the motor relative to the housing. There is simply no need or means for practically and easily disconnecting the wires from the Dicke motor.

G. Rejection of Claims 1, 2, 5, 8, 9, 12-26 and 30-32
Under 35 U.S.C. §103

These claims are rejected as being made obvious by a combination of any one of Dipnall, U.K. Patent No. 1,145,812, Fujitani, U.S. Patent No. 5,045,013 or Jolley, U.S. Patent No. 3,041,485, in combination with Klint et al., U.S. Patent No. 3,959,921.

Each of the primary references is cited for teaching "motor attachment plates or clips ...including a member received in an engage portion of the base...attachable to/detachable from the base." It is acknowledged, however, that each primary reference lacks at least a shaft type hinge connection, for which Klint et al. is cited.

For the following reasons, it is respectfully submitted that the present invention, as recited by these amended claims, was not made obvious by the cited combinations.

Dipnall '812 shows a slot car braking system wherein the motor 17 is held in place by a clip 20, and the "power supply to the motor 17 is through two wires, not shown leading via a terminal block 21 from shoes also not shown." Page 2, left Col., lines 11-14. This electrical connection is believed to be the conventional fixed type.

Fujitani '013 shows a clip 3d similar to that of Dipnall, but with resilient fingers 3f. Col. 3, lines 43-58. Again, "The power wire 5g [Figs. 4, 5] is connected through the control switch 5c to the motors 3b and 4b, thereby constituting a power supply circuit. Col. 4, lines 29-32. Without further clarification in Fujitani, it is expected that the connection of the wire 5g is fixed to the motor, as was conventional.

Jolley '485 shows a hinged portion 42 of a top wall over a compartment that is opened to receive a "power pack" 100, which houses motor(s) 112, 114, gears, etc., therein.

It is not believed that any of these references teaches or suggests, as recited in amended independent claims 1, 5, 8 or 30-32, a motor holding plate that contacts the motor when the plate is in a closed position to hold the motor in the motor containing part, and wherein the motor is connected to the power source, and that is movable into another position wherein the motor is not contacted and the motor is no longer electrically connected.

The question then, under Graham v. John Deere, is whether one of ordinary skill, being aware of these primary references, would have or could have been taught by Klint et al. to

modify the primary references to arrive at the invention recited by amended independent claims 1, 5, 8 and 30-32. It is respectfully submitted that the answer is no.

Klint merely relates to a pivotable cab for a toy, not a pivotable motor holding plate. In this regard, the toy of Klint is not even a powered toy. See Fig. 1 and Col. 1, lines 48-54. Even if Klint were to suggest to one of ordinary skill the use of a shaft for rotating a motor clip or plate, the reference, like the primary references, lacks at least any suggestion of forming a motor holding plate to contact the motor in a first position, wherein the motor is connected to a power source, which plate can be pivoted to another position, wherein the motor is not connected to the power source.

In regard to the dependent claims 12-26, none of the clips or lids of the primary references, or of Klint, is described as having any heat radiation ability or purpose. This is particularly true of Klint, wherein the "cab" is not associated with or even near a heat-generating member. Again, Klint does not even relate to a powered toy. See Fig. 1 and Col. 1, lines 48-54.

H. Rejection of Claims 1, 5, 8 and 27-29
 Under 35 U.S.C. § 103

These claims are rejected as being made obvious by the above-cited Fujitani alone, or in combination with Mabuchi, U.S. Patent No. 3,977,758. The former is cited for disclosing the motor attachment but not elastically engaged. Mabuchi is cited for disclosing the elastic engagement.

For the following reasons, it is respectfully submitted that the present invention, as recited by amended claims 1, 5, 8 and 27-29, was not rendered obvious by the cited combination.

Fujitani et al., as noted above, shows merely a removable clip to fix a motor in a chassis, and the motor appears to be conventionally connected to a power source via wires 5g. It fails to relate or teach a motor holding plate that pivots between open and closed positions, in the latter of which positions the plate contacts the motor in the motor containing part and the motor is connected to a power source, and when in the former of which positions, the motor is so contacted/connected to the power source.

On the other hand, Mabuchi relates to a battery retaining member, not a motor holding plate. As seen in Fig. 6, the motor of Mabuchi is fixed to the chassis as is conventional.

Accordingly, it is not believed that Mabuchi suggests to one of ordinary skill the use of a pivotable motor holding plate. If it did, Mabuchi would have incorporated same in its structure.

Even if one were merely to consider using the battery "gripping member" 7 of Mabuchi

with Fujitani, it is believed that same would be taught for securing the batteries shown in Fig. 5 of Fujitani. Instead, even applying the wing member 8 of the gripping piece 7 of Mabuchi with the clip of Fujitani, the present invention recited by these claims would not be made out. What same would yield is the clip 3 of Fujitani with a flexible end like "8" of Mabuchi which is already similar to the resilient finger 3f of Fujitani. There would be no pivoting action and there would be no difference in the engagement of the power source of the motor, which is by fixed wires in Fujitani, regardless of the position of the clip 3.

III. CONCLUSION

In light of the above amendments and remarks, it is respectfully submitted that claims 1-42 are now in condition for allowance.

If there are any additional fees associated with this Response, please charge same to our Deposit Account No. 19-3935.

Finally, if there are any formal matters remaining after this Response, the undersigned would appreciate a telephone conference with the Examiner to attend to these matters.

Respectfully submitted,

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1/26/05

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FIG. 1

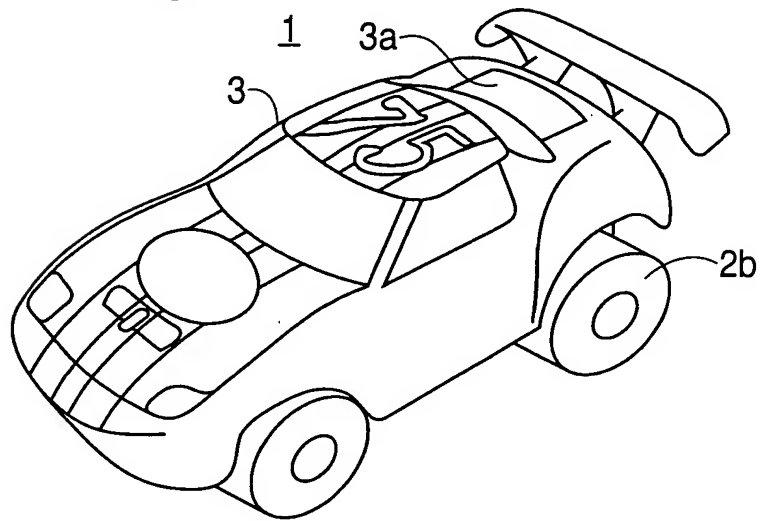


FIG. 2

